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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/469,727 12/21/99 MARINO

J 18608-004700

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EXAMINER

PHILOGENE, P

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 11/15/00

11/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/469,727

Applicant(s)

Marino et al.

Examiner
Pedro Philogene

Group Art Unit
3732



☒ Responsive to communication(s) filed on Dec 21, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5, 7, 8, 10, and 11 is/are rejected.

☒ Claim(s) 6 and 9 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 04

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-5,8,10,11 are rejected under 35 U.S.C. 102(e) as being anticipated by Dion (5,913,867).

With respect to claim 1, Dion discloses a bony tissue resecting system (10) comprising a cannula (12) having a side aperture (20) near its distal end; and a rotatable resecting element (14) received within the cannula (12).

With respect to claim 2, Dion discloses a system wherein the rotatable resecting element (14) can be distally advanced within the cannula.

With respect to claim 3, Dion discloses a system wherein the rotatable resecting element has a hollowed out distal end (15).

With respect to claim 4, Dion discloses a system further comprising an cannula positioning system (34) adapted to move the cannula from a first position to a second position, wherein the cannula points in the same direction at each of the first and second position.

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With respect to claim 5, Dion discloses a system further comprising a cannula positioning system adapted to move the cannula from a first position to a second position, as set forth in column 3, lines 40-59 and column 6, lines 35-39.

With respect to claims 8,10,11, the method steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above.

3. Claims 1, 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Drucker (5,964,777).

With respect to claim 1, Drucker discloses a bony tissue resecting system (10) comprising a cannula (14) having a side aperture (38,40,42) near its distal end; and a rotatable resecting element (12) received within the cannula (14).

With respect to claim 7, Drucker discloses a system wherein the cannula has an enclosed tapered end; as best seen in FIG.5.

Allowable Subject Matter

4. Claims 6 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

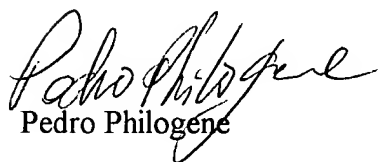
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Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,720,760	2-1998	Becker et al.
5,961,532	10-1999	Finley et al.
5,873,886	2-1999	Larsen et al.
5,755,718	5-1998	Sklar

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (703) 308-2252 and fax number is (703) 308-2708.


Pedro Philogene

Primary Examiner

November 13, 2000